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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
VON SEGGERN *et al.*
Appl. No. 09/482,682
Filed: January 14, 2000
For: **Adenovirus Vectors, Packaging Cell Lines, Compositions, and Methods for Preparation and Use**

Confirmation No.
Art Unit: 1648
Examiner: Foley, S.
Atty. Docket: 1294.0010001/RWE/LBB

Reply To Restriction Requirement

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated October 8, 2000, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of Group I , represented by claims 1-23, 41, 47, 69 and 70. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made with traverse because all the claims of Groups I - VI should be grouped together. All claims can be examined without serious burden because a search of the art for the claims of group I should find art relevant to the claims of any other group. Further, the claims of groups II - V are classified in the same class and are described by the Examiner as being drawn to adenovirus particles.

At a minimum, the claims of Groups II and III should be examined together because of what appears to be an arbitrary claim grouping. Both groups of claims are considered by the Examiner to be drawn to adenovirus particles, except one is a "fiber-altered" particle while the other is a "fiber-less" particle. Clearly, the search of art relevant to "fiber-altered"

would also be relevant to "fiber-less" particles. Further, claim 75 (Group III) is even dependent on claim 24 (Group II) . Finally, the claims of both groups are classified in the same class, i.e. 435.

SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN AND THE ENTIRE APPLICATION SHOULD THEREFORE BE EXAMINED ON THE MERITS

MPEP 803 (Seventh Edition, Rev. I (February 2000)), at page 800-3, right hand column, states as one of the criteria for restriction that : "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, . . ."

In the present case, Applicants respectfully assert that the search of more than one restriction group does not impose a serious burden upon the Examiner, as a search concerning the patentability of the claims of any one group is likely to uncover art of interest to the remaining groups. More specifically, the search of art related to one type of adenovirus particle should presumably result in information useful to consideration of claims drawn to other types of adenovirus particles. Any additional search that would be needed would not be an undue burden on the Examiner. Further, such information would also be useful in determining the patentability of all the additional groups of claims.

Additionally, the Examiner notes that several groups of claims are related to each other as a product and process of use of that product. Necessarily, that information used to examine patentability of the product will be relevant to the patentability of the process of using or making that product. Accordingly, for all of the above reasons and in the interest of efficient advancement of prosecution, it is respectfully requested that the Examiner should

reconsider and withdraw the restriction requirement. Furthermore, allowance of all pending claims is respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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